

### **REMARKS**

Claims 6-13, 16-24, 26-29 and 31-37 are pending in the present application. Applicant respectfully requests reconsideration of the present claims in view of the following remarks.

#### **I. Formal Matters:**

##### **Telephone Interview**

Applicant thanks Examiner Johnstone for briefly discussing the present application during a January 19, 2007 telephone interview. For at least the reasons discussed during the January 19, 2007 telephone interview and below, Applicant respectfully submits that presently presented claims 6-13, 16-24, 26-29 and 31-37 are patentable over the art of record.

##### **Notice of Appeal**

Applicant filed a Notice of Appeal with the appropriate fee (\$500.00) for the Notice of Appeal on February 15, 2007.

##### **Pre-Appeal Brief Request For Review**

Applicant submits herewith a Pre-Appeal Brief Request For Review. Applicant has requested a pre-appeal review for the reasons provided in the Pre-Appeal Brief Request, as well as the reasons provided in Applicant's August 14, 2006 Amendment and Response and below.

#### **II. Prior Art Rejections:**

##### **Claim Rejections Under 35 U.S.C. §102(b)**

Previously presented claims 6, 8, 16-17, 19-24, and 34 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Application No. 3-273975 (hereinafter, "JP'975"). This rejection is respectfully traversed for at least the reasons given in Applicant's August 14, 2006 Amendment and Response.

As discussed in Applicant's August 14, 2006 Amendment and Response, the disclosure of JP'975 fails to disclose Applicant's method as recited in independent claim 6. Specifically, JP'975 fails to disclose a method comprising heating a sheet material to a melt sealing temperature sufficient to (1) cause a melt-flowable composition of the sheet material to melt, flow and level out over surface imperfections or fill gaps in a step joint, while (2) a dimensionally stable film of the sheet material remains sufficiently dimensionally stable at the melt sealing temperature so as not to melt and flow or exhibit wrinkling.

In the November 16, 2006 final Office Action, Examiner Johnstone continues to focus on the construction of the tape (i.e., tape 4) disclosed in JP'975, not whether the disclosure of JP'975 discloses Applicant's claimed method. Applicant maintains the position that the disclosure of JP'975 fails to teach the method steps recited in independent claim 6. Even if the disclosed tape of JP'975 is suitable for use as a melt-sealing sheet material (and Applicant does not submit that this is the case), the disclosure of JP'975 still fails to disclose at least the above-described heating step recited in Applicant's independent claim 6.

As discussed in Applicant's August 14, 2006 Amendment and Response, JP'975 disclose a heating step wherein all of tape 4 softens and does not suggest in any way that a portion of tape 4 melts, while another portion of tape 4 remains dimensionally stable. In fact, the disclosure of JP'975 suggests just the opposite given that the top layer 4a is described as a "hot-melt film" (English translation of JP'975, page 8, line 7, beginning with "The tape 4 was once softened...") and that both of the tape layers 4a and 4b can comprise the same type of material. See, for example, page 6, lines 17-23 of the English translation, wherein JP'975 discloses that layer 4a and layer 4b may both comprise a urethane. If the two layers 4a and 4b comprise the same type of material, they should behave similarly when heated.

Given the failure of the disclosure of JP'975 to disclose each and every method step as recited in independent claim 6, the disclosure of JP'975 cannot anticipate Applicant's claimed invention as embodied in independent claim 6. Since claims 8, 16-17, 19-24, and 34 depend from independent claim 6, and recite additional claim features, the disclosures of JP'975 cannot anticipate Applicant's claimed invention as embodied in dependent claim 8, 16-17, 19-24,

and 34. Accordingly, withdrawal of this rejection under 35 U.S.C. §102(b) is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Previously presented claims 6, 8, 12-13, 16-17, 19-24, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975.

Previously presented claims 7, 9 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of U.S. Patent No. 4,822,683 to Schappert et al. (hereinafter, "Schappert") and U.S. Patent No. 4,920,182 to Manser et al. (hereinafter, "Manser").

Previously presented claims 10-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of U.S. Patent No. 4,877,679 to Leatherman et al. (hereinafter, "Leatherman1") and U.S. Patent No. 4,892,779 to Leatherman et al. (hereinafter, "Leatherman2").

Previously presented claims 18, 29, 31 and 36-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of Manser and Japanese Patent Application No. 58-217516 (hereinafter, "JP'516").

Previously presented claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of European Patent Application No. 0 384 598 A1 (hereinafter, "EP'598").

Previously presented claims 26-27 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of Manser and Japanese Patent Application No. 1-152049 A (hereinafter, "JP'049").

Previously presented claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP'975, and further in view of Schappert, Manser and JP'049.

Previously presented claims 6, 8, 12-13, 16-17, 20-24, 26-27, and 33-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and U.S. Patent No. 5,162,149 to Reaney (hereinafter, "Reaney").

Previously presented claims 7, 9, 28 and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and Reaney, and further in view of Schappert and Manser.

Previously presented claims 10-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and Reaney, and further in view of Leatherman1 and Leatherman2.

Previously presented claims 18, 29, 31 and 36-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and Reaney, and further in view of Manser and JP'516.

Previously presented claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and Reaney, and further in view of JP'975.

Previously presented claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP'049 in view of Shimizu and Reaney, and further in view of EP'598.

Previously presented claims 29, 31 and 36-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,739,919 to Artzt (hereinafter, "Artzt") in view of Manser and JP'516.

All of the above rejections under 35 U.S.C. §103(a) are respectfully traversed for at least the reasons given in Applicant's August 14, 2006 Amendment and Response.

Rejection of Previously Presented Independent Claim 6 and Its Dependent Claims:

Regarding the rejection of independent claim 6 under 35 U.S.C. §103(a) as being unpatentable over the teaching of JP'975 in combination with one or more of the teachings of Schappert, Manser, Leatherman1, Leatherman2, JP'516, EP'598, and JP'049, Applicant again notes that the teaching of JP'975 fails to teach or suggest a method comprising heating a sheet material to a melt sealing temperature sufficient to (1) cause a melt-flowable composition of the sheet material to melt, flow and level out over surface imperfections or fill gaps in a step joint, while (2) a dimensionally stable film of the sheet material remains sufficiently dimensionally stable at the melt sealing temperature so as not to melt and flow or exhibit wrinkling as discussed above. Each of the teachings of Schappert, Manser, Leatherman1, Leatherman2, JP'516,

EP'598, and JP'049, which are used in combination with JP'975, also fails to teach or suggest such a heating step as recited in independent claim 6. The teachings of Schappert, Manser, Leatherman1, Leatherman2, JP'516, and EP'598 are directed to various articles comprising an adhesive composition, but have nothing to do with vehicles, and especially a method for modifying a surface of a step joint in a vehicle body. The teaching of JP'049 is directed to a production method for making an automotive roof part, wherein the production method comprises placing a thermosettable rod within a roof ditch groove, and heating/curing the thermosettable rod so as to cause the rod to melt flow and seal surfaces of the roof ditch. Like the teaching of JP'975, the teaching of JP'049 fails to disclose, teach or suggest a heating step as recited in independent claim 6.

Again, in the November 16, 2006 final Office Action, Examiner Johnstone suggests that one of ordinary skill in the art would have been motivated to substitute a dimensionally stable film for the hot-melt base film layer in the tape structure of JP'975 because dimensionally stable films are well known in the art. See, for example, beginning on page 3, line 22 of the November 16, 2006 final Office Action where Examiner Johnstone states:

As to claims 12 and 13, oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyethylene terephthalate film as the hot-melt base film in the above method.

Applicant disagrees.

Applicant respectfully submits that the art of record fails to suggest the desirability of such a modification of the teaching of JP'975 as suggested by Examiner Johnstone. The teaching of JP'975 specifically discloses the use of a hot-melt layer as upper layer 4a, not a dimensionally stable layer, and especially not a dimensionally stable oriented polyethylene terephthalate film. As stated by the Court in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Further, the only suggestion of the desirability or need for using a dimensionally stable film in a method for modifying the surface of a step joint in a vehicle body has been gleaned from Applicant's own specification, not from what is suggested in the art of record.

Rejection of Previously Presented Independent Claim 28:

Regarding the rejection of independent claim 28 under 35 U.S.C. §103(a) as being unpatentable over (1) the teaching of JP'975 in combination with Schappert and Manser, or (2) the teaching of JP'049 in combination with Shimizu, Reaney, Schappert, and Manser, it should be noted, as discussed above, that each of the teachings of JP'975 and JP'049 fails to teach or suggest a method comprising heating a sheet material to a melt sealing temperature sufficient to (1) cause a melt-flowable composition of the sheet material to melt, flow and level out over surface imperfections or fill gaps in a step joint, while (2) a dimensionally stable film of the sheet material remains sufficiently dimensionally stable at the melt sealing temperature so as not to melt and flow or exhibit wrinkling, and especially the use of a dimensionally stable film in the form of an oriented polyester film as recited in independent claim 28. Further, each of the teachings of JP'975 and JP'049 fails to teach or suggest Applicant's claimed method wherein the melt-flowable composition of the sheet material comprises a semi-crystalline, thermosetting epoxy-polyester blend as recited in independent claim 28. In fact, the teaching of JP'975 specifically discloses the use of a nylon 12 melt-flowable composition, not a semi-crystalline, thermosetting epoxy-polyester blend.

For reasons similar to those given above, the art of record fails to teach or suggest Applicant's claimed method for modifying the surface of a vehicle, as well as the desirability of such a method. The only suggestion of Applicant's claimed for modifying the surface of a vehicle has been gleaned from Applicant's own specification, not from what is suggested in the art of record.

Rejection of Previously Presented Independent Claim 29 and Its Dependent Claims:

Regarding the rejection of independent claim 29 under 35 U.S.C. §103(a) as being unpatentable over (1) the teaching of JP'975 in view of Manser and JP'516, or (2) the teaching of

JP'049 in view of Shimizu, Reaney, Manser and JP'516, or (3) the teaching of Shimizu, or (4) the teachings of Sinclair or Conley, further in view of Kaul, Kline, and Douglas, or (5) the teaching of Artzt in view of Manser and JP'516, it should be noted, as discussed above, that each of the teachings of JP'975 and JP'049 fails to teach or suggest a method comprising heating a sheet material to a melt sealing temperature sufficient to (1) cause a melt-flowable composition of the sheet material to melt, flow and level out over surface imperfections or fill gaps in a step joint, while (2) a dimensionally stable film of the sheet material remains sufficiently dimensionally stable at the melt sealing temperature so as not to melt and flow or exhibit wrinkling, and especially the use of a dimensionally stable film having a paint-receptive upper surface comprising a thermosetting epoxy-polyester blend as recited in independent claim 29. It should be further noted that each of the teachings of Manser, JP'516, Shimizu, Reaney, Sinclair, Conley, Kaul, Kline, Douglas, and Artzt fails to teach or suggest Applicant's claimed method or the use of a sheet material having a paint-receptive upper surface comprising a thermosetting epoxy-polyester blend as recited in independent claim 29.

For reasons similar to those given above, the art of record fails to teach or suggest Applicant's claimed method for modifying the surface of a substrate, as well as the desirability of such a method. The only suggestion of Applicant's claimed method for modifying the surface of a substrate has been gleaned from Applicant's own specification, not from what is suggested in the art of record.

For at least the reasons given above, Applicant respectfully submits that Examiner Johnstone has failed to make a *prima facie* case of obviousness based on the combination of any of the teachings of JP'975, Schappert, Manser, Leatherman1, Leatherman2, JP'516, EP'598, JP'049, Shimizu, Reaney, Sinclair, Conley, Kaul, Kline, Douglas, and Artzt. There is no suggestion or motivation to combine select features of the above-described references as suggested by Examiner Johnstone other than the description of Applicant's own invention. Accordingly, withdrawal of these rejections is respectfully requested.

### III. Conclusion:

For at least the reasons given above, Applicant respectfully submits that claims 6-

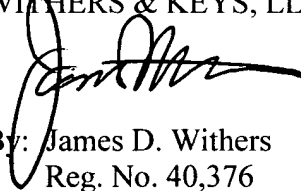
Request For Reconsideration  
Serial No. 08/421,055

13, 16-24, 26-29 and 31-37 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Johnstone believe that anything further is necessary to place the application in better condition for allowance, Examiner Johnstone is respectfully requested to contact Applicant's representative at the telephone number listed below.

Respectfully submitted,  
WITHERS & KEYS, LLC



By: James D. Withers  
Reg. No. 40,376

WITHERS & KEYS, LLC  
235 Bryan Street  
McDonough, Georgia 30253  
678-565-4748  
Attorney No. 10002.0098US01

3M Docket No.: 49286US003